

U.S.S.N. 09/932,802

IN-5521

REMARKS

Claims 1-4, 6-14, 16-41, and 43-70 remain in the application with claims 1 and 38 in independent form.

Claims 1-4, 6-14, 16-41, and 43-70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tatsuya et al. (JP 2000-271534) as generally recited in the prior Office Action in view of Anders et al. (United States Patent No. 6,005,024) and in further view of Spencer et al. (United States Patent No. 6,242,056), Murayama et al. (United States Patent No. 5,424,006), Schimmel et al. (United States Patent No. 5,585,427), and Zhao et al. (United States Patent No. 6,036,999).

The Applicant respectfully asserts that the Examiner has not established the requisite *prima facie* case of obviousness and, therefore, traverses this rejection.

As the Examiner is aware, to appropriately establish a *prima facie* case of obviousness, three basis criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Relative to the first criterion, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **and not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Furthermore, as the Examiner is also aware, precedential cases such as *In re Sang Su Lee* (277 F.2d 1338), *In re Zurko* (258 F.3d

U.S.S.N. 09/932,802

IN-5521

1379), and *W.L. Gore v. Garlock, Inc.* (721 F.2d 1540) require that the Examiner refrain from overly conclusory statements when making an argument to modify a reference or motivation to combine references. *Gore* specifically recognizes that it is improper, in determining whether a person of ordinary skill would have been led to a modification of a particular reference, simply to "[use] that which the inventor taught against its teacher."

Simply stated, there is no motivation to combine the teachings of Tatsuya et al. and Anders et al. Therefore, the first criterion is not satisfied. In fact, it can even be argued that Anders et al. teaches away from Tatsuya et al.

The claimed invention focuses on a method and a phosphorescent coating system where an at least partially-transparent clearcoat composition is applied wet-on-wet to an uncured film layer of a color-providing composition.

Contrary to the focus and teachings of the present invention and arguably the focus and teachings of Tatsuya et al., Anders et al. does not disclose, teach, or otherwise suggest such a scenario where an at least partially-transparent clearcoat composition is applied wet-on-wet to an uncured film layer of an underlying, color-providing composition. Instead, the transparent compositions in Anders et al. are merely overlaid upon existing 'things' (markings, surface areas, structures, or articles) (see *Abstract and the entire Anders et al. document*). A thorough review of Anders et al. clearly reveals that, no matter what 'thing' the transparent composition of Anders et al. is overlaying, the 'thing' is preexisting, i.e., already formed, such that it is already cured (if it even required a cure in the first instance). Thus, Anders et al. is in no way appropriately combinable with Tatsuya to arrive at the elements claimed in the present invention.

U.S.S.N. 09/932,802

IN-5521

Furthermore, contrary to the Examiner's contention, the articles overlayed in Anders et al. are not (and do not include) automobile parts. The Applicant's attorney has reviewed, in detail, the Anders et al. document and can find no reference, no matter how remote, to overlaying its transparent composition on automobile parts, let alone automobile parts that have an uncured film layer of a color-providing composition such that wet-on-wet application can be adopted. Instead, Anders et al. recites an extensive list of 'things' (from airport runways to traffic control devices/sings) and does not recite any form of automobile part whatsoever. In fact, by focusing on potential degradation by a vehicle (Column 3, lines 11-13) and on resistance to wear from tires of motor vehicles (Column 5, lines 15-16), the description in Anders et al. even recognizes that its transparent composition is not applicable to automobiles or automobile parts.

On Page 2 of the Office Action, the Examiner notes that Anders et al. teaches "a phosphorescent coating system wherein [a] phosphorescent pigment...is included in a transparent resin overlay to provide a phosphorescent protective coating layer on an article." This teaching alone does not make Anders et al. appropriately combinable with Tatsuya et al. Furthermore, even if, as the Examiner contends, these references can be combined, this fact alone does not render the resultant combination obvious unless the prior art suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) and MPEP Sec. 2143.01. There is nothing in the prior art, especially in the reference to Anders et al., that suggests the desirability of combining an overlay composition with an uncured film layer in a wet-on-wet manner to arrive at the claimed invention. In fact, as described above, based on the focus and teachings of Anders et al., it

U.S.S.N. 09/932,802

IN-5521

is more likely that such a combination is undesirable, if not entirely inappropriate.

In view of the remarks set forth above, the Examiner has not established the requisite *prima facie* case of obviousness because there is no motivation to combine the references in the manner suggested by the Examiner. As such, independent claims 1 and 38 are allowable and the remaining claims depend either directly or indirectly from the non-obvious features of claims 1 and 38 such that the dependent claims are also allowable.

It is respectfully submitted that the Application is now presented in condition for allowance, which allowance is respectfully solicited.

No fees are believed to be due. However, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

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